

Docket No. AVERP3012US

Serial No. 09/915,624

**REMARKS**

Claims 1-35 are pending in the present application. Claims 8 and 21 have been withdrawn.

Claim 1 is amended herein to correct a typographical error. No other claims are amended herein.

A new proposed drawing (Fig. 3A) is submitted, in which a release liner described in the specification at page 52, lines 17-27, has been shown.

The specification is amended to make reference to the new proposed drawing, by an insertion in the Brief Description of the Drawings at page 5, and by an amendment of the paragraph at page 52, lines 17-27, to include reference to the new drawing and the reference numeral 62 identifying the release layer described there and shown in Fig. 3A.

No new matter is included in any of the foregoing amendments.

Applicant respectfully requests reconsideration and withdrawal of the rejections of Applicant's claims based on the foregoing amendments and the following remarks.

**Objection to the Drawings**

The proposed new drawing Fig. 3A shows three release liners, as described at page 52, lines 17-27. Applicant requests entry of the new drawing and the proposed amendment of the specification making reference thereto. Applicant submits that no new matter is included in either the proposed new drawing or the proposed amendment of the specification.

In addition to the foregoing, Applicant noted that Fig. 6 includes an erroneous reference numeral and submits herewith a proposed corrected drawing sheet to correct the error. Specifically, the reference numeral 38, which is described in the specification as referring to the lower end 38 of the flap 30, is erroneously repeated at the left side of Fig. 6 with a lead line to the lower end of the first adhesive layer 50. Applicant proposes to delete both the erroneous reference numeral 38 and the lead line leading from this numeral to the layer 50 as shown in the attached proposed drawing correction for Fig. 6. The Examiner is requested to indicate approval of this proposed correction.

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Claims 34 and 35 stand rejected as lacking support in the specification. Applicant respectfully traverses this rejection. Claim 34 recites a second release liner attached to the upper surface of the first adhesive layer 50. This release liner was described in the paragraph at page 52, lines 17-27 as filed and herein amended, and has been shown in new proposed drawing Fig. 3A as the layer 62. Claim 35 recites a third release liner attached to the lower surface of the second adhesive layer 58. The Examiner is respectfully referred to the release liner 60 in Figs. 3 and 6, which is attached to the adhesive layer 58, which is the claimed third release liner. Alternatively, claim 34 may be considered to refer to the release liner 60, and claim 35 may be considered to refer to the release liner 62.

Thus, the subject matter of claims 34 and 35 is fully supported in the application as filed. The Examiner is requested to withdraw this rejection of claims 34 and 35.

**Rejections Over the Prior Art**

Claims 1-6, 9-14, 16-20, 22, 24, 25 and 27-33 stand rejected as anticipated by Kobe et al., U.S. Patent No. 5,888,335; claims 7 and 23 stand rejected as obvious over Kobe et al. in view of Howard, U.S. Patent No. 4,495,318; and claims 15 and 26 stand rejected as obvious over Kobe et al. in view of Freedman, U.S. Patent No. 4,543,139. Applicant respectfully traverses the rejections of all of these claims for at least the following reasons.

**Failure to State a *Prima Facie* Case of Anticipation**

Applicant respectfully submits that the Examiner has failed to state a *prima facie* case of anticipation in setting forth the rejection over Kobe et al. In order to state a *prima facie* case of anticipation, the Examiner must identify every element of the claimed invention, arranged as in the claims under consideration. The Examiner failed to carry this burden, since the statement of the rejection at page 3-4 of the Office Action fails to identify all of the elements arranged as in the claims.

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Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.), *cert. denied*, 110 S.Ct. 154 (1989). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *In re Coker*, 463 F.2d 1344, 1348, 175 USPQ 26, 29 (CCPA 1972). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001).

The statement of the rejection identifies only isolated parts of the claimed invention in Kobe et al., and does not show how Kobe et al. discloses every element of the claimed invention arranged as in Applicant's claims. For this reason, the rejection is improper and should be withdrawn.

Fig. 5 of Kobe et al. is considered to be the closest to Applicant's claimed invention, despite the fact that since it is not a resealable container. Side-by-side comparison of the Kobe et al. Fig. 5 structure and the claimed structure shows that there can be no possible anticipation of the claimed structure by that of Fig. 5 of Kobe et al.

Kobe et al. Fig. 5
paper 90
tacky PSA 93
backing 96
non-tacky fastening 12
target 100
backup pad

Claim 1 - Fig. 3
extended body portion 30
first adhesive 50
release liner 48
releasable adhesive 54
sheet member 52
second adhesive 58
main body portion 14

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Even if the positions of the non-tacky fastening 12 and the target 100 in Kobe et al. are switched, there is still no anticipation because the layers and relationships set forth in claim 1 are not found in Fig. 5 of Kobe et al. In Kobe et al., Figs. 1-3 are tapes, and obviously do not include all of the layers claimed by Applicant. Fig. 4 includes two non-tacky fastening layers 12 and does not include layers corresponding to the layers recited in Applicant's claim 1, despite the Examiner's contention to the contrary in response to Applicant's arguments. Fig. 4 of Kobe et al. and the disclosure cited by the Examiner are discussed in more detail below in the section on the Examiner's response to Applicant's arguments and amendments.

The Examiner failed to identify every element of Applicant's claimed invention in Kobe et al., thus failing to state a *prima facie* case of anticipation. Having failed to state a *prima facie* case of anticipation, the rejection of Applicant's claims 1-6, 9-14, 16-20, 22, 24, 25 and 27-33 as anticipated by Kobe et al. must be withdrawn.

**Kobe et al. Fails to Disclose a Releasable Adhesive**

Kobe et al. does not disclose a releasable adhesive, and for this additional reason, Applicant's claims cannot be anticipated by Kobe et al. The fastening system of Kobe et al. does not employ an adhesive as the "active" or functional fastener. In the Summary of the Invention, at col. 1, lines 52-57, Kobe et al. discloses:

The invention involves a multi-cycle refastenable contact responsive non-tacky fastener system. The fastening component of the system comprises a contact responsive fastening layer which has a surface that possesses essentially no surface tack, is multiply releasable and refastenable against a non-tacky target surface. (Emphasis added.)

This distinction is further emphasized in the first lines of the Detailed Description, at col. 3, lines 13-15:

The invention relates to a new class of fastener structures that has at least one contact responsive fastening

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layer which has essentially no surface tack to paper. The contact responsive fastening layer allows multiple fastening and releasing cycles of the fastening layer with a target surface. The target surface may comprise either another essentially tack free surface or it may simply be a non-tacky smooth surface. (Emphasis added.)

Applicant submits that the "new class of fastener structures" is so identified because it is not an adhesive as that term is known and used by those of ordinary skill in the art and in Applicant's specification and claims.

Kobe et al. does not refer to either part of the disclosed refastenable system as an adhesive, but rather as "a new class of fastener structures". While other parts of the refastenable system (such as mounting layers) use adhesives and, when Kobe et al. intends to identify these materials as adhesives, Kobe et al. clearly and distinctly does so identify them, the fastening component of the Kobe et al. system clearly does not comprise an adhesive. Kobe et al. consistently refer to the fastening component of the system by using terms other than "adhesive", and avoid referring to the fastening component as an adhesive, since it is not an adhesive.

Although the structure disclosed by Kobe et al. appears to have a number of similarities to Applicants' claimed invention, the structure of Kobe et al. differs in this one fundamental way: Kobe et al. uses a non-tacky surface applied to a non-tacky substrate, and does not use a releasable adhesive as disclosed and claimed in Applicants' application and claims.

The Examiner failed to identify every element of Applicant's claimed invention in Kobe et al., thus failing to state a *prima facie* case of anticipation. Having failed to state a *prima facie* case of anticipation, the rejection of Applicant's claims 1-6, 9-14, 16-20, 22, 24, 25 and 27-33 as anticipated by Kobe et al. must be withdrawn.

**Howard Fails to Remedy the Shortcomings of Kobe et al.**

Claims 7 and 23 stand rejected as obvious over Kobe et al. in view of Howard, U.S. Patent No. 4,495,318. Applicant traverses the rejection of claims 7 and 23 on this ground.

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Claims 7 and 23 recite that the releasable adhesive comprises adhesive microspheres. This feature further distinguishes over Kobe et al., which requires that the fastening layer be non-tacky. Addition of the microspheres of Howard to the non-tacky fastening layer of Kobe et al. would render tacky the non-tacky fastening layer, thus defeating the purpose of the alleged invention.

Howard fails to remedy the shortcomings of Kobe et al. Howard relates to inherently tacky, elastomeric, solvent-dispersible, solvent-insoluble, polymeric microspheres that are prepared using a non-ionic emulsifier. Given the disclosure contained therein, Howard fails to cure the deficiencies of Kobe et al. This is because Howard fails to disclose or suggest a structure for a releasable closure. If a person of ordinary skill in the art attempted to combine Howard with Kobe et al., the person would have to use the microspheres of Howard in one of the pressure-sensitive adhesive layers of Kobe et al., not in the non-tacky fastening layer of Kobe et al. To use the microspheres of Howard in the non-tacky fastening layer of Kobe et al. would render the layer tacky, which is directly opposed to the disclosure of Kobe et al. When an asserted combination or modification would destroy or significantly change the way a prior art device operates, the asserted combination or modification is improper and cannot support a case of *prima facie* obviousness.

**Freedman Fails to Remedy the Shortcomings of Kobe et al.**

Claims 15 and 26 stand rejected as obvious over Kobe et al. in view of Freedman et al., U.S. Patent No. 4,543,139. Applicant traverses the rejection of claims 15 and 26 on this ground.

Claims 15 and 26 recite that the releasable adhesive adheres to the main body portion or to the extended body portion with a peel strength greater than one pound per inch. This feature simply states that the releasable adhesive adheres to the main body portion or the extended body portion more strongly than it adheres to the release liner.

This feature distinguishes over Kobe et al. for the same reasons set forth about with respect to the base claims, and because Kobe et al. does not disclose a peel strength for the fastening layer 12 to the mounting layer 17. Freedman et al. fails to remedy the

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shortcomings of Kobe et al. Freedman et al. relates to resealable package closures which have two layers of adhesive joined together at an interface there between. The resealable package closures of Freedman et al. are said to operate by placing the exposed surface of a permanent pressure sensitive adhesive 11 onto a substrate 31, the surface of a second pressure sensitive adhesive 12 remains covered by a release liner until an end-user of the packaging desires to re-close same. Once re-closure is desired, release liner 22 is removed from PSA layer 12 and a portion 32 of the package to be resealed is brought into contact with PSA layer 12. As can be seen from Figures 1E to 1H of Freedman et al., a reseal interface 16 is created between the top surface of PSA layer 12 and portion 32 of the package to be resealed.

Accordingly, Applicant respectfully submits that the combination of Kobe et al. with Freedman et al. would not have rendered obvious Applicant's claims 15 and 26.

With respect to the obviousness rejections over Kobe et al. in combination with either of Howard or Freedman, Applicant respectfully submits that the Examiner has failed to state a case of *prima facie* obviousness with respect to Applicant's claims 7, 15, 23 and 26. The Examiner has failed to identify all of the limitations of Applicant's claims in the prior art, has failed to identify any motivation to select the recited features of Applicant's claimed invention, and has failed to show a reasonable expectation of success. In particular, the Examiner has failed to show the *prima facie* obviousness of the claimed invention in that the Examiner has failed to identify all the elements of the base claims as set forth above in the section on the anticipation rejections.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the obviousness rejections of claims 7, 15, 23 and 26.

**Claims 34 and 35 Further Distinguish Over the Cited Prior Art.**

Claims 34 and 35 were not included in the art rejections, presumably based on the contention that these claims lack support. This contention has been overcome for the reasons set forth above.

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Claims 34 and 35 depend from claim 33, and provide further distinctions over the cited prior art, in addition to the differences pointed out in the foregoing. With regard to claim 34, Kobe et al. fails to disclose a structure including, in this order, a second release liner, a first adhesive, a first release liner, a releasable adhesive, a sheet member and a second adhesive, as shown in the figure below. With regard to claim 35, Kobe et al. fails to disclose a structure including, in this order, a first adhesive, a first release liner, a releasable adhesive, a sheet member, a second adhesive and a third release liner, as shown in the figure below.

Claim 34
second release liner 62
first adhesive 50
release liner 48
releasable adhesive 54
sheet member 52
second adhesive 58

Claim 35
first adhesive 50
release liner 48
releasable adhesive 54
sheet member 52
second adhesive 58
third release liner 60

For these reasons, both claim 34 and claim 35 further distinguish over Kobe et al. and are respectfully submitted to be allowable.

#### **Responses to Arguments.**

In response to Applicant's arguments, the Examiner contended that Kobe et al. discloses in Fig. 4 and col. 6, lines 47-67 an optional structure that corresponds to Applicant's claimed invention. Applicant disagrees, because while it may correspond in some ways, it does not anticipate Applicant's claimed invention. The Examiner contended:



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See Kobe et al in Fig. 4 and Col. 6, lines 47-67, where either one of layers 12 can be a non-tacky layer or a release liner and that layers 31 of each tape 60 and 53 are optional. This allows for one of the layers being present in one tape and not the other. With layer 31 being in tape 53 and upper layer 12 being the non-tacky the structure meets the amended claims. This is inherent in the reference.

Applicant traverses this contention. This contention apparently is based on the erroneous position that the following disclosure at col. 6, lines 55-59 means that a target layer may be substituted into the Fig. 4 structure in place of one non-tacky fastening layer:

Alternatively, either of the two fastening layers (but not both) may be replaced with a target surface having a non-tacky characteristic and which is chosen to yield appropriate peel and shear strengths when in contact with a fastening layer surface.

Applicant respectfully submits that the Examiner's position is clearly erroneous. First of all, the "target surface" is not disclosed by Kobe et al. as a release liner. Kobe et al. discloses, for example at col. 3, lines 17-19, "The target surface may comprise either another essentially tack free surface or it may simply be a non-tacky smooth surface." Kobe et al. disclose, for example, at col. 5, lines 5-19, that the target surface may be any of a variety of materials, but none of the disclosed materials constitute a release liner or layer. The only mention of release liner in Kobe et al. is for covering the conventional adhesives used, e.g., in the mounting layer 17. The Examiner has failed to identify any disclosure in Kobe et al. that says the target surface is or may be a release liner.

Furthermore, a more straightforward and realistic reading of the disclosure at col. 6, lines 55-59 quoted above is that either of the two tapes 53 and 60 may be applied to an appropriate target surface, not that a target surface may be substituted into the structure of Fig. 4 for one of the non-tacky fastening layers.

Furthermore, as set forth in detail above, the non-tacky fastening layer of Kobe et al. is not an adhesive as described and claimed in the present application. Thus, even if

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the "target surface" is actually substituted for one of the fastening layers as contended by the Examiner, there is still no anticipation, because every claim limitation is not present.

For either of the foregoing reasons, Applicant respectfully traverses the Examiner's contentions as to the disclosure of Kobe et al. at col. 6, lines 47-67 as set forth in the final Office Action in the Examiner's response to Applicant's arguments and amendments.

In addition, the Examiner's position that the substitution would be the same as Applicant's claimed invention based on the contention that "this would be inherent in the reference" is clearly erroneous. For missing disclosure to be inherent, it must necessarily be present in the reference and a person of skill in the art must recognize that it is present. Based on Applicant's showings that (1) the Kobe et al. non-tacky fastening layer is not an adhesive and (2) that the Kobe et al. target surface is not a release liner, the missing disclosure is not necessarily or even possibly present in the disclosure, and there is no way that a person of skill in the art would recognize the missing disclosure to be present in the disclosure of Kobe et al. Accordingly, for this additional reason, Applicant's claimed invention is not anticipated by Kobe et al.

#### **CONCLUSION**

For the foregoing reasons, Applicant respectfully submits that all of the pending claims patentably distinguish over the prior art, and that therefore the present application is in condition for allowance. Applicant respectfully requests the Examiner to so indicate.

In the event the Examiner considers that a telephone interview would be helpful in advancing the present application, the Examiner is requested to telephone the undersigned attorney at the Examiner's convenience.

In the event issues arise as a result of the filing of this paper, or remain in the prosecution of this application, Applicants request that the Examiner telephone the undersigned attorney to expedite allowance of the application. Should a Petition for Extension of Time be necessary for the present Reply to the outstanding Office action to be timely filed (or if such a petition has been made and an additional extension is necessary) petition therefor is hereby made and, if any additional fees are required for the

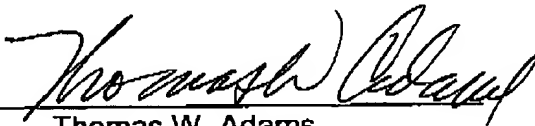
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filing of this paper, the Commissioner is authorized to charge those fees to Deposit Account #18-0988, Docket No. AVERP3012US.

Respectfully submitted,  
RENNER, OTTO, BOISSELLE & SKLAR, LLP

Date: June 1, 2004

By



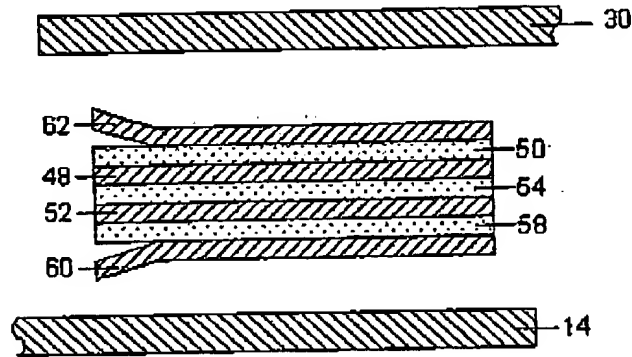
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Proposed New FIG. 3A

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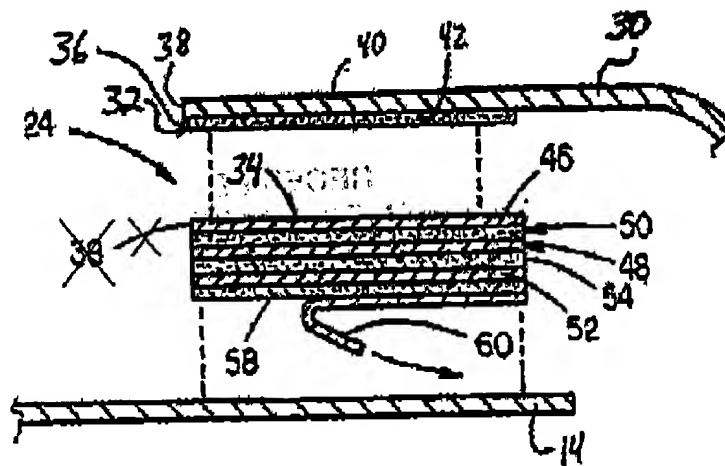


FIG. 6

Fig. 6 is amended by deletion of the reference numeral 38 and the lead line marked out with "X" above. The amended Fig. 6 will appear as shown below:

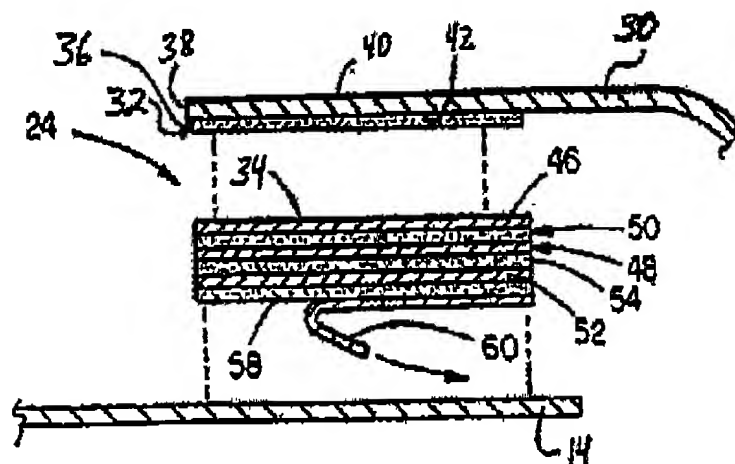


FIG. 6